

Application No. 10/074,959
Amendment dated 23 April 2007

Attorney Docket No. SPEC-6150

REMARKS/ARGUMENTS

Applicants respectfully submit the following remarks in connection with the above-referenced patent application.

Claims 1-19 and 21-32 are pending in this application. Claims 6-9 and 17-19 are allowed. Applicants note that this is a second, non-final Office Action, with the addition of Mazur et al. (U.S. Patent No. 5,401,246) forming new grounds of rejection.

I. Claims 1, 2, 15, 16, 29 and 30 are patentable over Neiimeister '352.

Claims 1, 2, 15, 16, 29, and 30 stand rejected under 35 U.S.C. 102(b) as being anticipated by Neiimeister et al. (U.S. Patent No. 4,560,352). Applicants respectfully traverse this rejection. Applicants' descriptions of Neiimeister et al. and the present invention are detailed in the October 30, 2006 Response.

In the June 29, 2006 Office Action, the grounds of rejection state that Neiimeister et al. disclose a plunger assembly having a shaft 46, a handle 51 attached to a first end of the shaft, and a dispenser hub assembly including a collar 45 and a handle 61 attached to the collar. Further, the grounds of rejection allege that Neiimeister et al. disclose a hollow tube or casing 4.

In the October 30, 2006 Response, Applicants argued that one of ordinary skill in the art would not consider finger 51 (see col. 4, lines 2-10) as a "handle" attached to a shaft. Rather finger 51 is used as a guide in conjunction with longitudinal slot 52 to guide spindle 46 such that the spindle is secured against rotation relative to the sleeve 41 (Id). By its ordinary definition, Applicants argued, a "handle" is part that is designed especially to be grasped by the hand (see <http://www.m-w.com/dictionary/handle>).

In the present Office Action at page 10, in the Response to Arguments section, the grounds of rejection address the aforementioned argument stating that claims must be interpreted as broadly as their terms reasonably allow. The grounds of rejection argue that "[f]inger 51 is a part that can be held by a hand and thus meets that definition of a handle." Applicants respectfully submit that this definition of a handle put forth by the Examiner is not an ordinary definition of a handle as would be understood by one of ordinary skill in the art, as indicated by the definition above, and is an overly broad interpretation. For example, the Examiner's definition would make any part of the Neiimeister et al. device a "handle" since any part of the device would be a "part that can be held by a hand."

Further, Applicants other argument put forth in the October 30, 2006 Response was not addressed in this Office Action. That is, Neiimeister et al. teach away from the use of a handle. As argued previously, the Neiimeister et al. device is based on a "one hand" operated dispenser to overcome the problems of the prior art as discussed in the Description of the Invention at col. 1. In operation, a right hand is used such that handle 61 rests against the ball of the thumb and is surrounded by the middle, fourth, and little fingers. The index finger and thumb are used to rotate casing 44 as the device is held in this manner. As such, Neiimeister et al. actually teaches

Application No. 10/074,959
Amendment dated 23 April 2007

Attorney Docket No. SPEC-6150

away from a handle on a shaft since a two-handed operation would be needed. Accordingly, independent claims 1, as well as independent claims 29 and 30 which also include this feature distinguish from the Neiimeister et al. device. Claims 2, 15, and 16 are allowable over Neiimeister et al. at least based in their dependence on claim 1.

II. Claims 1, 2, 10, 15, 16, 29 and 30 are patentable over Preissman '190.

Claims 1, 2, 10, 15, 16, 29, and 30 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,383,190 to Preissman. Applicants respectfully traverse this rejection. The disclosure of Preissman is discussed in the October 30, 2006 Response, and accordingly, is not repeated herein.

As in the prior Office Action, the grounds of rejection state that Preissman disclose a shaft 76' with handle 72 attached to the shaft, a dispenser hub assembly having a collar and a handle 75, and a hollow tube 74' removeably engaged with the dispenser hub assembly. These features are recited in independent claims 1, 29, and 30.

In the October 30, 2006 Response, Applicants argued that item 74' in the Preissman device is part of the hub assembly and not a removable attachable hollow tube. As noted above, the grounds of rejection allege that item 74' is a hollow tube that is removeably attached to the dispenser hub assembly. However, from the disclosure of Preissman, item 74' (or 74 in Figure 10) is a column that is threaded and mates with column 76 (the shaft as characterized in the grounds of rejection) (see col. 12, lines 13-26 and Figure 11). Therefore, item 74' in the Preissman device is part of the hub assembly and not a removable attachable hollow tube.

In the present Office Action, on page 10, in the Response to Arguments section, the grounds of rejection state that "Preissman clearly shows that collar 82 is provided with a hinge pin 84 which is insertable into a recess 86 in column 74' for providing therewith or allowing removal of the section altogether" (citing col. 12, lines 49-56).

Applicants respectfully submit that one problem with the grounds of rejection is that it does not identify which part of the Preissman device is the claimed dispenser hub in view of item 74' being alleged as the claimed hollow tube. Applicants noted above that item 74' in the Preissman device is part of the hub itself, as clearly shown in Figure 11. Taking the new argument put forth in the Response to Arguments section of the Office Action, Figure 11 shows that recess 86 (as well as hinge pin 84) are a part of what would be considered a hub by one of ordinary skill in the art, and not associated with any hollow tube portion. As such, the "removeably attached" feature is not disclosed or suggested by Preissman. Should the Examiner not agree that the claims distinguish over Preissman based on the arguments herein, the Examiner is kindly requested to clearly indicate which portion of the Preissman device is alleged as the claimed hollow tube, and which portion is alleged as the claimed hub in a non-final Office Action.

Applicants note that an advantage of having a hollow tube being removably attached to a dispenser hub is that the hollow tube can be directly removed without having to first unthread the

Application No. 10/074,959
Amendment dated 23 April 2007

Attorney Docket No. SPEC-6150

shaft. This cannot be done by the Preissman device. Therefore, Applicants respectfully submit that the claims distinguish from Preissman.

III. Claims 1, 2, 10, 15, 16, 29 and 30 are patentable over Pierson '992.

Claims 1, 2, 10, 15, 16, 29, and 30 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,571,992 to Pierson et al. Applicants respectfully traverse this rejection.

Pierson et al. disclose a dispensing syringe. The grounds of rejection state, inter alia, that Pierson et al. disclose a dispenser hub assembly having a collar 60 and a hand grip 51 attached to the collar 60. This feature is recited in independent claims 1, 29, and 30.

In the October 30, 2006 Response, Applicants argued that there is no disclosure or suggestion in the disclosure of Pierson et al. that hand grip 51 is attached to collar 60. Rather "handle" 51 is part of gripping assembly 40. Gripping assembly 40 mates with a threaded section of barrel 20 (see col. 3, lines 14-31). An extruding section of barrel 20 (threaded portion 34) mates with nut 60 (alleged by the grounds of rejection as the collar) (see col. 3, lines 46-51). As such, Applicants argued, there is no attachment between the gripping assembly 40 and nut 60. Rather, they are both individually secured to the barrel 20.

In the Response to Arguments section of the present Office Action, the grounds of rejection respond to this argument by stating that "Figure 1 clearly shows collar 60 to be attached to or joined to hand grip 51. Applicants traverse this assertion, pointing to the actual disclosure of Pierson et al. as discussed above at col. 3, lines 46-51 which indicates how the gripping assembly 40 and nut 60 are both individually secured to the barrel 20. Further, Applicants respectfully submit that there is nothing in Figure 1, such as threads or grooves on either of assembly 40 and nut 60 which would suggest an attachment as the term would be understood by one of ordinary skill in the art. Accordingly, claims 1, 2, 10, 15, 16, 29, and 30 distinguish from Pierson et al.

IV. Rejections Under 35 U.S.C. § 103.

Claims 4 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable in over Preissman in view of Mazur et al. (U.S. Patent No. 5,401,246). Claims 4 and 5 are dependent on claim 1 and are allowable over Preissman for at least the reasons discussed above for claim 1. Mazur et al., used only to show an o-ring mounting configuration, does not make up for the deficiencies of Preissman.

Claims 11, 12, and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Preissman. Claims 12, 13, 31, and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Preissman in view of U.S. Patent No. 4,312,343 to LeVeen et al. Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Preissman in view of U.S. Patent No. 5,603,701 to Fischer. Claims 4 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pierson et al. in view of Mazur et al. Claim 3 stands rejected under 35

Application No. 10/074,959
Amendment dated 23 April 2007

Attorney Docket No. SPEC-6150

U.S.C. § 103(a) as being unpatentable over Pierson et al. in view of Preissman. Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Pierson et al. Claims 12, 13, 31, and 32 stand rejected under 35 U.S.C. § 103(a) as being Pierson et al. in view of LeVeen et al. Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Pierson et al. in view of Fischer.

Applicants respectfully submit that these claims are allowable at least based on their dependency on their respective independent claims. Discussion of reasons as to why the cited art in these rejections is deficient is discussed above.

Applicants further request that should the claims not be allowed based on the arguments above, that the Examiner further clarify the rejection of claim 12, as it is rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Preissman and also under 35 U.S.C. § 103(a) as being unpatentable over Preissman in view of LeVeen et al.

Claims 21-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,395,007 to Bhatnagar et al. in view of Preissman. Claims 21-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bhatnagar et al. in view of U.S. Patent No. 5,638,997 to Hawkins et al. Claims 21 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,156,606 to Chin in view of Hawkins et al. Claims 22-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chin and Hawkins, and further in view of Preissman. Applicants respectfully traverse these rejections.

As argued in the October 30, 2006 Response, in order to establish a *prima facie* showing of obviousness under Section 103, the Examiner must set forth three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the reference teachings. See MPEP § 706.02(j), 2142 (8th ed., 2nd Rev., 2004). Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or the references when combined must teach or suggest all of the claim limitations. *Id.*

The only apparent motivation for combining the references above arises from Applicants' disclosure and the claimed invention itself, which constitutes impermissible hindsight motivation and cannot be relied upon as a reason to combine references. See, e.g., *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

With respect to the rejections based on Bhatnagar et al. and Hawkins et al., and Chin and Hawkins et al., Applicants first note that the Examiner has not met the standard for an obviousness rejection since the Examiner provides no motivation to combine the references. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Here, the Examiner fails to show a motivation for combining the references, and only alleges that they are functionally equivalent. Being functionally equivalent perhaps only satisfies the second part of the test as described above. The Examiner does not provide the motivation for the combination as in the first part of the test. Nor

Application No. 10/074,959
Amendment dated 23 April 2007

Attorney Docket No. SPEC-6150

has the Examiner clearly shown how, when combined, the references teach or suggest all of the claim limitations.

In this Office Action, the Examiner, when discussing obviousness in the Response to Arguments section states that the "test is what the combined teachings of the references would have suggested to one of ordinary skill in the art", citing *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Applicants respectfully submit that this teaching from *In re Keller* relates to whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference. The bodily incorporated test does not negate the requirement that the Examiner identify the motivation for the combination of the references. As such, Applicants respectfully submit, and maintain, that these rejections are improper. Should the Examiner not withdraw the rejections, the Examiner is kindly requested to provide the motivation for their combination as well as further define how each of the references teach the "recited" features of the claims.

In view of the foregoing, Applicants respectfully submit that the cited references do not teach or suggest the claimed subject matter and request withdrawal of the rejections of the claims under Section 103.

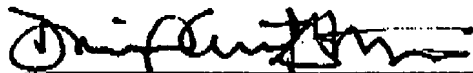
V. Conclusion.

Applicant respectfully submits that claims 1-15 are in condition for allowance and respectfully request the Examiner to pass said claims 1-15 on to issue. Should the Examiner have any questions concerning the above, or believe that issues remain in the case, Applicant respectfully requests the Examiner to contact the undersigned counsel, who may be reached by telephone to 513.248.6208.

It is believed that no fee is required for the present amendment. In the event that a fee is required, the Commissioner is hereby authorized to charge any deficiency or credit any overpayment to deposit account number 03-2469. Moreover, if the deposit account contains insufficient funds, the Commissioner is hereby invited to contact Applicant's undersigned representative to arrange payment.

Respectfully submitted,

Date: 23 April 2007



Daniel C. Stelter, Reg. No. 40,830
Counsel for Applicants
1430 Waukegan Road, MPKB-A1
McGaw Park, Illinois 60085
847-578-6650 direct, 847-578-4448 fax
daniel.stelter@cardinalhealth.com